REMARKS

Status of the Claims and amendments

Claims 1 and 5 are pending. Claims 1 and 5 are rejected. Claim 1 is amended herein. Claim 1 is amended to replace the term "comprising" with "consisting" to overcome 35 U.S.C. 103 rejection. The specification has been amended to include Trastuzumab and Rituximab, the generic names for HERCEPTIN® and RITUXAN®, respectively to overcome Examiner's objection. Additionally, the specification has also been amended for grammatical errors.

The 35 U.S.C. §103, Obviousness Rejection

Claims 1 and 5 stand rejected under 35 U.S.C. 103(a) for the reasons previously set forth in the Final rejection mailed March 2, 2004, Section 5, pages 3-4 as well as for the reasons previously set forth in the Paper mailed November 5, 2003, Section 10, pages 14-17. Applicants respectfully traverse this rejection.

The Examiner finds Applicants' argument regarding lack of teaching about effectiveness of treatment with HERCEPTIN® alone in the prior arts combined unpersuasive due to use of the term "comprising" in the claims which does not exclude combination therapies. Additionally, the Examiner finds Applicants' argument regarding no reasonable expectation of success in arriving at the claimed invention for the reason discussed *supra*.

Applicants have amended claim 1 by replacing the term "comprising" with the term "consisting of". Based on this amendment, Applicants submit that the claim is now directed to a method of treating uterine serous papillary carcinoma that overexpress HER-2/neu by administering to an individual with the carcinoma a therapeutically effective dose of a humanized murine anti-HER-2/neu monoclonal antibody 4D5 alone that binds to the extracellular domain of HER-2/neu.

Furthermore, Applicants submit that the prior art that teach over-expression of HER-2/neu and those that are directed to the use of HERCEPTIN® in treating cancers combined do not teach or suggest all elements of Applicants' amended claim. This is especially critical since the cited prior art (**Pegram** *et al.*, **Bookman** *et al.*) found low response rates for treatment with HERCEPTIN ® alone. In fact, **Bookman** *et al.* explicitly state that based on low frequency of HER-2/neu over-expression and very low response rates to single agent HERCEPTIN®, it would be practical to combine HERCEPTIN® with platinum based therapy. **Bookman** *et al.* further suggest targeting other related signal transduction molecules to increase the proportion of patients that might benefit from a combined therapy approach (page 289, col. 2, last paragraph). Thus, the cited arts combined do not provide one of ordinary skill in the art with motivation to treat uterine serous papillary carcinoma with HERCEPTIN® alone with reasonable expectation of success.

Despite this, if one of ordinary skill in the art were motivated to treat HER-2/neu over-expressing uterine serous papillary carcinoma with HERCEPTIN® as claimed in the instant invention, one would be merely trying to arrive at the claimed invention. It has long been established that merely "trying" is not a standard for obviousness under 35 U.S.C. 103. Thus, Applicants contend that the subject matter of the instant invention was not obvious to one of ordinary skill in the art at the time the invention was made since the **cited prior art references** combined do not suggest all elements of the instant invention nor do they provide an incentive or motivation to produce the claimed invention with reasonable expectation of success. Accordingly, based on the amendment and above-mentioned remarks, Applicants respectfully request the withdrawal of rejection of claims 1 and 5 under 35 U.S.C.103.

The 35 U.S.C. §112, First Paragraph Rejection

Claims 1 and 5 are rejected under 35 U.S.C. 112, first paragraph as the specification does not contain a written description of the claimed invention. Applicants respectfully traverse this rejection.

The Examiner states that the limitation of "humanized murine anti-HER-2/neu monoclonal antibody 4D5" has no clear support in the specification and the claims as originally filed. Furthermore, the Examiner states that review of the specification discloses support for HERCEPTIN® which is known to be a murine anti-HER-2/neu monoclonal antibody 4D5, but does not disclose support

for the broadly claimed antibody. Applicants respectfully disagree with the Examiner.

The Applicants' specification clearly discloses HERCEPTIN® to contain human framework regions with the complementary-determining regions of a murine monoclonal antibody that binds to the Mr 185,000 extracellular determinant of HER-2/neu (see page 18, lines 9-12). Furthermore, based on the amendments to the specification, mailed December 11, 2003, HERCEPTIN® was described as a humanized murine anti-HER-2/neu monoclonal antibody (MAb) 4D5 (page 4, lines 6-10). Additionally, it is also well-known in the art for HERCEPTIN® to be a humanized murine monoclonal antibody 4D5 (see enclosed description of HERCEPTIN® available online and in Physician's desk reference page 1301, col. 2). Therefore, contrary to the Examiner's contention of no support for HERCEPTIN® to be a humanized murine monoclonal antibody 4D5, the Applicants have shown support for the same in their specification as well as in the art. Accordingly, based on these remarks, Applicants respectfully request the withdrawal of rejection of claims 1 and 5 under 35 U.S.C. 112, first paragraph.

Objection

The specification is objected to because of the multiple recitations of the terms Herceptin and Rituxan in the absence of an indication that these terms are trademarks. The Examiner states that these terms should be

capitalized or marked as trademarks, wherever they appear and be accompanied by generic terminology if applicable. Applicants respectfully traverse this objection. Applicants have amended the specification as discussed *supra*. Based on these amendments, Applciants respectfully request the withdrawal of these objections.

This is intended to be a complete response to the Office Action mailed February 7, 2004. Applicants submit that the pending claims are in condition for allowance. If any issues remain outstanding, please telephone the undersigned attorney of record for immediate resolution.

Respectfully submitted,

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Benjamin Aaron Adler, Ph.D., J.D.
Registration No. 35,423
Counsel for Applicant

ADLER & ASSOCIATES
8011 Candle Lane
Houston, Texas 77071
(713) 270-5391 (tel.)
(713) 270-5361 (facs.)
badler1@houston.rr.com